REMARKS

The Specification has been amended. Claims 1, 18, and 20 - 21 have been amended. Claims 22 - 24 have been added. No new matter has been introduced with these amendments or added claims, all of which are supported in the application as originally filed. Claims 3 - 4, 13, 17, and 19 have been cancelled from the application without prejudice (and Claims 2 and 5 - 12 were previously cancelled from the application without prejudice.) Claims 1, 14 - 16, 18, and 20 - 24 remain in the application.

Applicants are <u>not</u> conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, and claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I.   <u>Rejection under 35 U. S. C. §101</u>

Page 3 of the Examiner's Answer dated March 1, 2010 (hereinafter, "the Examiner's Answer") states that Claim 21 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection also refers to paragraph **[0078]** of Applicants' Specification, which discusses computer usable storage media. In the interest of progressing rapidly to issuance, Applicants have amended this paragraph of the Specification herein to state that the computer

usable media excludes a signal. Accordingly, the Examiner is respectfully requested to withdraw the §101 rejection.

II.   Rejection under 35 U. S. C. §103(a)

Claims 1, 3 - 4, and 13 - 21 were previously rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2004/0043758 to Sorvari et al. (hereinafter, "Sorvari") in view of U. S. Patent 6,731,393 to Currans et al. (hereinafter, "Currans"). This rejection is discussed in the Examiner's Answer, and is respectfully traversed herein with regard to remaining Claims 1, 14 - 16, 18, and 20 - 21 (and added Claims 22 - 24) as currently presented.

Section 2143.03 of the MPEP, "All Claim Limitations Must Be Considered" (which is found within Section MPEP §2143, titled "Examples of Basic Requirements of a *Prima Facie* Case of Obviousness"), quotes ***In re Wilson***, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that "All words in a claim must be considered in judging the patentability of that claim against the prior art." (emphasis added)

Applicants respectfully submit that neither Sorvari nor Currans, nor any combination thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art was motivated to attempt it), teaches or suggests all words of the claim recitations of their independent Claims 1, 19, and 20 as currently recited, as will now be discussed.

Referring first to independent Claim 1, this claim, as currently presented, recites:

A computer-implemented method of enabling users to subscribe to content in a computing environment <u>without initiating a subscription process</u>, comprising:

identifying a content access behavior pattern of a user;

responsive to the identifying, <u>consulting a mapping that associates content access behavior patterns of users with corresponding candidate content subscriptions to be offered to users exhibiting the associated content access behavior patterns</u>, thereby determining a selected one of the candidate content subscriptions which corresponds to the identified content access behavior pattern of the user, <u>the selected one indicating a subset of content generated by a content source</u>;

<u>offering, to the user, a subscription to the subset of the content by rendering a subscription interface for the subset, the subscription interface comprising a Web page which is distinct from a Web page usable for rendering the content generated by the content source</u>;

responsive to acceptance of the offered subscription by the user, storing a trigger document associated with the user and the content, <u>the trigger document specifying at least one condition associated with the subset</u>; and

<u>subsequently evaluating a then-current version of the content generated by the content source, using the at least one condition specified in the trigger document, to determine whether a then-current version of the subset of the then-current version of the content is considered a match to the at least one condition</u>, and if so, <u>automatically sending the then-current version of the subset to the user as the subscription and scheduling time on an electronic calendar of the user</u>.
(emphasis added)

With reference to an example illustrated in Applicants' Specification, a "content access behavior pattern of a user" may comprise interacting with a shopping web page **100**, an example of which is illustrated in **Fig. 1**. Based on the user's content access behavior pattern, a candidate content subscription is determined by consulting a mapping. The candidate content subscription allows the user to be offered a subscription to a <u>subset</u> of the content generated by a content source. See, for example, the "Candidate Subscription" Web page **400** which is illustrated in **Fig. 4**. In this example, the user can subscribe to receive updates of the content subset represented by reference numbers **420, 430, 440**.

Page 8 of the Examiner's Answer states

> ... the Appellant does not specifically define what the "mapping" is or what a subscription could or could not be. The Examiner considers the "mapping" to "content subscriptions" the same as a type of history data that links previously selected web sites to web sites a user might want to select or "subscribe to".

Applicants have amended their claim language herein to more clearly recite the claimed "mapping". In particular, Applicants do not claim a "history data" type of file that specifies "links ... to web sites a user might want to ... subscribe to". Instead, as recited in the above-underlined claim language from lines 4 - 10 of Claim 1, the mapping is consulted to determine a "selected one of the candidate content subscriptions [that] indicat[es] a subset of content generated by a content source" (emphasis added). With reference to the example in **Figs. 1 - 2**, for example, the candidate content subscription is not the Web page **100**, but instead is the subset thereof which is shown in **Fig. 2** by dashed rectangles. See **Fig. 4**, where the fields from these dashed rectangles are provided on the Candidate Subscription page **400** at reference numbers **420, 430, 440**. This is not the same as the bookmarking/selection of services described in Sorvari's paragraphs **[0052]**, **[0061] - [0067]**, and **[0073] - [0078]**, which provide for viewing an entire Web page.

Page 8 of the Examiner's Answer also states "This also is part of the interpretation of 'indicating at least one portion of content generated by the content source' [referring to the claim language as previously presented] which is the URL being displayed to the user." (emphasis added). Applicants' claim language does not recite a way to display a URL stored in a history file, or to display the Web page which is available from a URL stored in a history file. See the discussion of subscribing to a subset of content, above, referring to the example in **Figs. 1**, **2**, and

4.

       Page 9 of the Examiner's Answer states

            ... Appellant's "trigger" is not specifically defined and therefore is up for interpretation as to what a "trigger" could be. The history data, criteria and user environment are used in the filter is interpreted as the "trigger".

       Applicants have amended their claim language herein to more clearly recite the claimed "trigger". In particular, Applicants do not claim a file storing "history data, criteria and user environment". Instead, as recited in the above-underlined claim language from lines 17 - 19 of Claim 1, the trigger document "specif[ies] at least one <u>condition associated with the subset</u> [of content to which the user subscribes]" (emphasis added). The conditions from the trigger document are then used for matching to a then-current version of the subset to see if the then-current version should be sent to the user (Claim 1, lines 20 - 26). An example of conditions in a trigger document is illustrated in **Fig. 8**, where "condition_1" and "condition_2" are defined using names and values for content within the subset. The trigger document, as currently recited in Claim 1, is not the same as sensing environmental conditions for providing recommendations to a user as described in Sorvari's paragraphs **[0085] - [0088]**, which do not appear to describe a "then-current version" of a "subset [of content]".

       Page 9 of the Examiner's Answer further states "A user selecting the URL [sent to the user] is 'responsive to accepting the offered subscription'.". Applicants have amended their claim language herein to more clearly recite that the user is not subscribing to a URL. Instead, as recited in the above-underlined claim language from lines 13 - 16 of Claim 1, the user is offered a

subscription to the <u>subset</u> of the Web page, and this subscription is offered "by rendering a subscription interface ... the subscription interface comprising a Web page which is distinct from a Web page usable for rendering the content ...". See, for example, the sample subscription interface provided in **Fig. 4**. This is not the same as using an op code to determine what service to recommend to a user, as discussed in Sorvari's paragraph **[0088]**, which does not appear to offer the user a subscription to a <u>subset</u> of content.

For example, assume that Sorvari's approach provides a recommendation of "finding the nearest McDonald's", as discussed on page 10 of the Examiner's Answer, it is unclear what the user <u>subscribed to</u>. As presently presented, the claim language on lines 20 - 26 of Claim 1 recites that if a "then-current version of the subset of the then-current version of the content" is considered a match to at least one condition, then this "then-current version of the subset" is sent to the user. If the location of the nearest McDonald's is sent to the user, according to the analysis in the Examiner's Answer, then this McDonald's location would need to align to Applicants' recited "then-current version of the subset". Applicants are unable to determine where Sorvari discloses a subset to which the user subscribed (Claim 1, lines 13 - 16) that would cause a trigger document to be stored (Claim 1, lines 17 - 19) containing condition(s) for subsequently evaluating a then-current version of some content (Claim 1, lines 20 - 26) which would result in "nearest McDonald's" being sent to the user as the "then-current <u>version of the subset</u>" (Claim 1, lines 23 - 25, emphasis added).

Page 10 of the Examiner's Answer states, with reference to the recited "... and scheduling

time on an electronic calendar of the user" (Claim 1, line 25) that Sorvari "... still reads on the claims that the information is <u>sent on a time schedule</u>" (emphasis added). Applicants respectfully submit that this is an incorrect interpretation of their claim language, which does not recite <u>sending</u> information <u>on a time schedule</u>. The above-underlined claim language from lines 20 - 26 of Claim 1 recites <u>two actions</u> occurring when a match is found, namely (1) automatically sending the then-current version of the subset [of the content] to the user as the subscription and (2) scheduling [some] time on a user's electronic calendar. For example, if the then-current version of the subset is information about a new version of a computer or peripheral, the user might want to spend some time <u>reviewing</u> that information, and accordingly, the claim language recites that time is <u>scheduled</u> on the user's electronic calendar. This scheduling may comprise, by way of example, blocking out a 15-minute time period on the user's calendar so that the user can review the information about the new version of the computer or peripheral without interruption. See paragraphs **[0061]** and **[0065]** of Applicants' Specification, where this scenario is described, as well as **Fig. 7**, where reference number **720** illustrates one way in which the user can select the amount of time to be blocked out. This sending of the then-current version of the subset, and also scheduling time on the user's electronic calendar, when a <u>match</u> occurs is not the same as periodically sending a newspaper to a user as described by Currans. In particular, Applicants find no matching of a then-current version of a subset of content that triggers the sending in Currans, in sharp contrast to Applicants' recited claim language.

In view of the above, Applicants respectfully submit that the cited references fail to disclose all of the claim language recited in independent Claim 1, when considering <u>all the words</u>

recited therein as required by MPEP §2143.03. Independent Claim 1 is therefore deemed patentable over the references as currently presented. Dependent Claims 14 - 16 and 18 (as well as newly-added Claims 22 - 24) are deemed patentable at least by virtue of the patentability of Claim 1 from which they depend. Independent Claims 20 and 21 recite claim language analogous to that of independent Claim 1, and are therefore considered patentable over the references according to the same analysis presented above with regard to Claim 1. The Examiner is therefore respectfully requested to withdraw the §103 rejection of all remaining claims as currently presented.

III.   Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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